

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
LEUNG *et al.*

Serial No.: 09/988,013

Filed: November 16, 2001

Title: IMMUNOCONJUGATES AND HUMANIZED
ANTIBODIES SPECIFIC FOR B-CELL
LYMPHOMA AND LEUKEMIA CELLS

Group Art Unit: 1643

Examiner: David Blanchard

Attorney Docket No.: IMMU-0014US2

Confirmation No.: 7681

VIA EFS-WEB

PETITION UNDER 37 CFR § 1.183

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Sir:

This is a petition to request that the requirement that a declaration under 37 CFR 1.131 be signed by all of the inventors in an application be waived for Patent Owner's Appeal Brief. The fee of \$400 for this petition under 37 CFR 1.17(f) is addressed in the EFS-Web generated transmittal, however, the Commissioner is authorized to charge any deficiency in the fee, or any other necessary fee, to Deposit Account 18-2056.

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.

The present situation is extraordinary, and justice requires that the PTO accept the Declaration under 37 CFR 1.131 of Hans Hansen alone, without requiring a Declaration under 37 CFR 1.131 of Shui-On Leung. MPEP 715.04 explicitly provides that a petition under

37 CFR 1.183 is appropriate in a situation where a declaration under 37 CFR 1.131 of an inventor cannot be obtained.

MPEP 715.04 provides that the following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

MPEP 715.04 further provides that:

Where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the oath or declaration for patent application under 37 CFR 1.63 is now unavailable to sign an affidavit or declaration under 37 CFR 1.131, the affidavit or declaration under 37 CFR 1.131 may be signed by the remaining joint inventors provided a petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted with the affidavit or declaration under 37 CFR 1.131. Proof that the non-signing inventor is unavailable or cannot be found similar to the proof required for a petition under 37 CFR 1.47 must be submitted with the petition under 37 CFR 1.183 (see MPEP § 409.03(d)). Petitions under 37 CFR 1.183 are decided by the Office of Petitions (see MPEP §1002.02(b)).

Applicant now petitions under 37 CFR 1.183 to proceed under MPEP 715.04(D), using only the declaration of Dr. Hans Hansen ("the other party in interest"). As previously stated, Dr. Leung no longer is employed by Immunomedics. Applicant sent a Rule 131 declaration to Dr.

Leung's attorneys, who forwarded it on to Dr. Leung for signature. However, Dr. Leung still has not yet returned his executed declaration.

More particularly, a Declaration under 37 CFR 1.131 like that executed by Dr. Hansen, suitably amended to reference Dr. Leung as the declarant, was forwarded to Dr. Leung's attorneys by Bryan Wilson on October 5, 2009. Mr. Wilson served as counsel to Immunomedics in connection with litigation in which Dr. Leung was plaintiff and cross-defendant. Mr. Wilson also forwarded, on October 21, 2009, a declaration revised to include changes suggested by Dr. Leung. Dr. Leung's attorney, Mr. Lantier, informed Mr. Wilson on November 5, 2009 that Dr. Leung still refused to sign the proffered Rule 131 declaration. These facts are documented in a declaration of Mr. Wilson which was submitted by applicant on December 28, 2009.

Accordingly, it is believed that applicant has taken all necessary steps to obtain a declaration from Dr. Leung, and that since Dr. Leung has not provided such a declaration that the granting of this petition under 37 CFR 1.183 is proper. Further, it is submitted that proof that applicant attempted to obtain a signed Declaration under 37 CFR 1.131 of Dr. Leung is suitably documented in the record. Applicant should be allowed to proceed under MPEP 715.04(D) with just Dr. Hansen's declaration. As the co-inventor of this subject matter, Dr. Hansen qualified as "the other party in interest" which is specified in MPEP 715.04(D).

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP

AUGUST 30, 2010

DATE

/BARBARA A. McDOWELL/

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